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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,595	06/20/2006	Eric Francis Morand	11982.105003(BDW004)	2505

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KING & SPALDING LLP
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EXAMINER

CHU, YONG LIANG

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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02/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,595	Applicant(s) MORAND ET AL.	
	Examiner YONG CHU	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/12/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 40, and 41 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,40, and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6 is/are rejected.
- 7) ☒ Claim(s) 1, and 3-4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/07/2005, and 03/06/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 7-39, and 42-46 have been cancelled by the Amendment filed on 01/28/2008. Therefore, claims 1-6, 40, and 41 are pending in the instant application.

Information Disclosure Statement

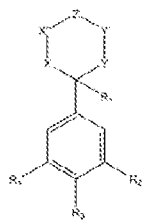
Applicants' Information Disclosure Statements, filed 10/07/2005, and 03/06/2006 have been considered. Please refer to Applicant's copy of the PTO-1449 submitted herewith.

Priority

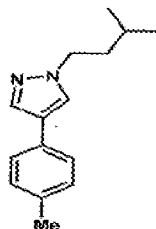
This application is a 371 of PCT/AU04/00453, filed on 04/07/2004, which claims foreign priority of Australia Patent Applications 2003901579 filed on 04/07/2003, and 2003906773, filed on 12/08/2003.

Response to Lack of Unity/Restriction Requirement

Applicants have made counter-proposal for elected subject matter drawn to a



compound of formula (I), wherein **Z** represents a covalent single bond between **X'** and **Y'**; **X** and **X'** taken together form $-\text{C}(\text{R}_5)=\text{N}-$; **Y'** is $-\text{N}(\text{R}_5)-$; and **Y** is $-\text{C}(\text{R}_5)-$ and taken together with the carbon atom bearing the phenyl ring forms a double



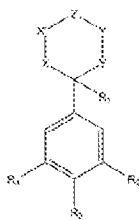
bond. Applicant further elected the compound shown in Example 13 as compound 13 as elected species. The Examiner has accepted Applicant's proposal. However, the proposed group lacks unity of invention due to the art rejection, therefore the elected scope of invention is further limited.

Since the Office has accepted the new group proposed by Applicant, the previous Restriction Requirement Office action dated on 06/14/2007 has been withdrawn.

Status of the Claims

Elected and Examined Subject Matter

The scope of the invention of the elected subject matter and the examined subject matter is as follows:



A compound of formula (I) , wherein **Z** represents a covalent single bond between **X'** and **Y'**; **X** and **X'** taken together form $-\text{C}(\text{R}_5)=\text{N}-$; **Y'** is $-\text{N}(\text{R}_5)-$; and **Y** is $-\text{C}(\text{R}_5)-$ and taken together with the carbon atom bearing the phenyl ring forms a double bond, wherein **R**₂ and **R**₄ are independently $-\text{H}$, or C₁₋₃alkyl; **R**₃ is C₁₋₃alkyl; and **R**₅ is C₁₋₂₀alkyl.

As a result of the election and the corresponding scope of the invention identified supra, claim 2, 5, 40, 41, and the remaining subject matter of claims 1, 3, and 4 are further withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups, which are chemically recognized to differ in structure, function, and reactivity. Claims 40 and 41 are pharmaceutical composition claims, which are patentably distinct from the examined compound claims, and may be rejoined the compound claims if the compound claims are allowable. Therefore, claims 1, 3-4, and 6 are examined on the merits.

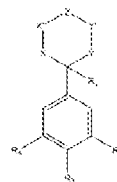
Claim Rejections - 35 USC § 102(b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-4, and 6 are rejected under 35 U.S.C. 102 (b) as being anticipated by Barrett et al., *PCT publication WO2003-013518* ("the '518 publication").

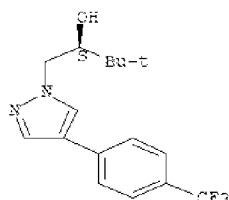


Applicants' claims relate to a compound of formula (I) , wherein **Z** represents a covalent single bond between **X'** and **Y'**; **X** and **X'** taken together form –C(**R**₅)=N-; **Y'** is –N(**R**₅)-; and **Y** is –C(**R**₅)- and taken together with the carbon atom

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bearing the phenyl ring forms a double bond, wherein R_2 and R_4 are independently $-H$, or C_{1-3} alkyl; R_3 is C_{1-3} alkyl; and R_5 is C_{1-20} alkyl.

The '518 publication (published on 02/20/2003) disclose the compound (CAS RN



497946-99-3). This compound was disclosed as an intermediate in example 1f on page 44 of the specification, which reads on the instantly claimed scope of invention wherein **Z** represents a covalent single bond between **X'** and **Y'**; **X** and **X'** taken together form $-C(R_5)=N-$; **Y'** is $-N(R_5)-$; and **Y** is $-C(R_5)-$ and taken together with the carbon atom bearing the phenyl ring forms a double bond, wherein R_2 and R_4 are $-H$; R_3 is C_{1-3} alkyl; and R_5 is C_{1-20} alkyl. The R_3 is defined as C_{1-3} alkyl, which may be optionally substituted with one or more times by halo (e.g. Cl, F, or Br) according to the instant Specification at paragraph [0095], page 10, and can be $-CF_3$. Therefore, the prior art compound anticipates the instant claims.

Claim Objections

Claims 1, and 3-4 are objected to for containing elected and non-elected subject matter. The elected subject matter has been identified supra.

Conclusion

- Claims 1, 3-4, and 6 are rejected.
- Claims 1, and 3-4 are objected to.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached between 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yong Chu, Ph.D.
Patent Examiner
Art Unit 1626

/Joseph K. McKane/
Supervisory Patent Examiner
Art Unit 1626

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